

references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention, including (but not limited to)

- a combination of transmitter and receiver;
- a chest strap supporting a first resonant sensor spaced laterally apart from a second resonant sensor;
- a microphone housed with said chest strap which communicates with transmitter control circuitry housed therein;
- a light means housed within the receiver;
- an analog to digital microphone amplification circuit in communication with a microphone;
- a conventional radio frequency receiver communicating with an antenna and

controlled by a digital to analog speaker amplification circuit in communication with a speaker;

- 11 • 6 a respiration monitor for monitoring the respiration of the user as well as interacting with the transmitter control circuitry for transmitting a respiration alarm signal within the monitor;
- 9 • 11 a first resonant sensor for detecting respiration and movement of the infant a second resonant sensor for detecting heart rate and pulse;
- 10 • a signal processor that compares the respiration related signal pattern to a stored pattern, and monitors the heart rate or pulse as compared with an initial baseline measurement;
- 11 • 1 a comparator circuit that determines if either of the measured characteristic fall below an alarm point, and generate an alarm output impulse that communicates with the radio frequency transmitter, forming an synthesized signal that communicating with an antenna and results in an alarm or annunciation signal of a predetermined frequency for audible transmission through said speaker of said receiver.

When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making a combination baby monitor, night

light, and respiration montitor. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

The Court of Appeals for the Federal Circuit (CAFC) in its opinion in In re Fine, 837 F.2d. 1071,1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988), (later upheld in In re Dance, 160 F.3d. 1339, 48 USPQ 2d. 1635 (Fed. Cir. 1998), sets forth the test of how the disclosure or teaching of references should be applied under 35 USC §103:

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d. 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so". Id., Here, the prior art contains none. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986);

In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



John D. Gugliotta, P.E., Esq.
Registration No. 36,538

The Law Offices of John D. Gugliotta
202 Delaware Building
137 South Main Street
Akron, OH 44308
(330) 253-5678
Facsimile (330) 253-6658



Summary of Specification Amendments per 37 C.F.R. §1.121

In the Specification

On page 6, line 6, please delete reference numeral "22" and replace with reference numeral -21-.

On page 7, lines 10, 12, and 15, please delete reference numeral "18" and replace with reference numeral -19-.

RECEIVED
APR 19 2001
TECHNOLOGY CENTER 2600

RECEIVED
APR 24 2001
TC 2600 MAILROOM